

Unregistered mark owner successfully opposes application by former licensee Examination/Opposition
Cancellation

Israel - Gilat, Bareket & Co, Reinhold Cohn Group

National procedures

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An IP adjudicator at the [Israeli Trademarks Office](#) has upheld an opposition filed by the owner of the unregistered trademark APOLLO against its former licensee's application to register the mark for goods in Class 11 of the [Nice Classification](#), and revoked the licensee's existing registration for the mark for goods in Class 7 (March 8 2009).

[Sakal Duty Free Ltd](#), a former licensee of SB Krispin Paamon Bell Ltd, owned the trademark APOLLO for dishwashers and washing machines in Class 7 (Registration 164419). In 2002 Sakal sought to register the APOLLO mark for kettles, toasters, coffee machines, bread makers and clothes driers in Class 11 (Application 157545). SB Krispin opposed the application, claiming that it was the owner of the mark based on long-term use. SB Krispin also sought to cancel Sakal's existing registration for the APOLLO mark.

The IP adjudicator found that SB Krispin had started using the APOLLO mark long before Sakal. In addition, Sakal was authorized to use the mark only because it had entered into a licensing agreement with SB Krispin. The licensing agreement had been the subject of proceedings before a magistrates' court, which had held that the agreement was not limited to ovens, stoves and extractors.

The IP adjudicator noted that registrations for the APOLLO mark for refrigerators, air conditioners, mini-bars, computers, printers, fax machines and cameras were held by third parties, [Tadiran](#) and [Hewlett-Packard](#). In addition, SB Krispin had not opposed Sakal's application for the registration of APOLLO in respect of irons.

However, the IP adjudicator emphasized that:

- rights in a mark are acquired through use; and
- granting the authorization to use a trademark does not prejudice the rights of the trademark owner and does not confer ownership on the authorized user.

The IP adjudicator further held that even though defensive registrations are prohibited under Israeli law, the scope of protection of a mark is not limited solely to the goods for which the mark is actually used, but extends to similar goods. Trademark owners must be able to expand their activities and prevent competitors from using the mark in respect of similar goods. However, if the trademark at issue is not a well-known registered mark, the list of goods may be extended only with caution.

The IP adjudicator thus upheld SB Krispin's opposition and revoked Sakal's registration for the trademark APOLLO. Costs were awarded to SB Krispin.

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